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2   Roger Schlafly, Pro Per
       PO Box 1680
3   Soquel, CA   95073
       telephone: (408) 476-3550

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6   FILED
                                           AUG 05 1997
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                                    RICHARD W. WIEKING
                                CLERK, U.S. DISTRICT COURT
                            NORTHERN DISTRICT OF CALIFORNIA
8   In the United States District Court   SAN JOSE
    for the Northern District of California

9

10 ROGER SCHLAFLY, Plaintiff   ) Case C-94-20512 SW PVT
        v.   ) Opposition to RSADSI Motion
11 PUBLIC KEY PARTNERS, and   ) on MIT Patent Infringement
) Hon. Spencer Williams
12 RSA DATA SECURITY INC., Defendants.) 10 am, Aug. 27, 1997

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18 Schlafly opposes RSADSI's motion regarding MIT patent infringement,

19 and rebuts RSADSI arguments A, B, C, below.

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21 A. RSADSI argues that the MIT inventors never surrendered the use

22 of the RSA algorithm. This argument is plainly contrary to the

23 record. In RSADSI's Exh. B, towards the beginning of the

24 "REMARKS", MIT says, "However, there are no mathematical

25 algorithms in the applicants' claims." This sentence is

26 underlined for emphasis. There are no typos, and the context

27 clearly indicates that MIT meant what it said.

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OPPOS RSADSI MOT SUM JUDG   page 1

1   RSADSI tries to spin this as saying that "no mathematical

2   algorithms in the applicants' claims" really meant "the claims do

3   not wholly preempt abstract mathematical claims". This

4   interpretation is contrary to plain English. One quote says the

5   claims do not contain a mathematical algorithm, and the other says

6   the claims do not consist solely of mathematical algorithms. This

7   distinction has a huge legal significance as well. The question

8   of statutory subject matter for an invention such as this is

9   usually analyzed with the Freeman-Walter-Abele test, which was the

10   emerging standard at the time of the MIT application. "It is

11   first determined whether a mathematical algorithm is recited

12   directly or indirectly in the claim. If so, it is next determined

13   whether the claimed invention as a whole is no more than the

14   algorithm itself; that is, whether the claim is directed to a

15   mathematical algorithm that is not applied to or limited by

16   physical elements or process steps." Arrhythmia, 958 F.2d at

17   1058, 22 USPQ2d at 1037. So MIT's argument was that the claims

18   are statutory by passing step 1 of the test, not step 2 as RSADSI

19   now suggests.

20

21   B. RSADSI's argument that the examiner did not rely on the MIT

22   statement that "there are no mathematical algorithms in the

23   applicants' claims" is also without merit. The examiner gave MIT

24   a 35 USC 101 rejection for nonstatutory subject matter. MIT

25   explicitly cited the two-step test enunciated in In re Freeman,

26   573 F.2d 1237, 197 USPQ 464 (CCPA 1978), and disclaimed any

27   coverage of mathematical algorithms in order to pass step 1, and

28   avoid the step 2 analysis, just as Freeman did. The examiner

OPPOS RSADSI MOT SUM JUDG   page 2

1 accepted the argument, and withdrew his rejection on that basis.

2

3 One could theorize today that the examiner understood MIT's

4 argument, and decided on his own and without telling anyone that

5 the subject matter is statutory based on a step 2 analysis. Such

6 a theory would have no legal consequences if true, because MIT is

7 committed to what it said on the record. But the theory is very

8 unlikely to be true anyway. MIT's argument in support of its step

9 1 analysis is mathematical gobbledygook, and if the examiner had

10 understood it then he would have also understood that it is

11 mathematically fallacious. It is much more likely that the

12 examiner accepted MIT's disclaimer of coverage of mathematical

13 algorithms on its face value, and allowed the claim on that basis.

14

15 C. RSADSI argues disingenuously that Schlafly is not entitled to

16 an advisory opinion on the scope of the MIT patent because he has

17 no potentially infringing activity. At the July 25, 1997 Schlafly

18 deposition, RSADSI's lawyer Rob Fram had information on Schlafly's

19 "CSP" product and asked him about it. That product offers a well-

20 defined RSA capability for those customers licensed to use it.

21 RSADSI suggests [RSADSI Motion, p. 8, footnote 6] that Schlafly is

22 barred from making such a product. This is a justiciable

23 controversy.

24

25 Conclusion

26

27 The history of the MIT patent shows that the patent examiner

28 rightly gave it a 35 USC 101 rejection for being nonstatutory

OPPOS RSADSI MOT SUM JUDG   page 3

1 subject matter. MIT managed to bluff the examiner by renouncing

2 any claim on mathematical algorithms and with a clever but utterly

3 bogus argument about mathematical formulas. MIT got the patent

4 but has to live with the estoppel it created. It cannot take back

5 what it gave up during patent prosecution before the Patent

6 Office.

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8 Dated: August 4, 1997

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10 By: _____

11 Plaintiff, Roger Schlafly

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2   CERTIFICATE OF SERVICE
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   Schlafly v. Public Key Partners and RSA Data Security Inc.
4 Case No. C-94-20512-SW, (PVT).
   Filed on July 27, 1994, San Jose, Calif.
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   The undersigned hereby certifies that he caused a copy of:
6
           Opposition to RSADSI Motion on MIT Patent Infringement
7   Opposition to PKP Motion on MIT Patent Infringement
           Exhibits GA-GJ
8
   to be served this date by First Class Mail upon the
9
   persons at the place and address stated below which is
10
   the last known address:
11
           Thomas R. Hogan
12   60 S Market St Ste 1125
           San Jose, CA 95113
13
           Robert D. Fram
14   Heller et al
           525 University Ave
15   Palo Alto, CA 94301

16 and to be emailed to the following:

17   Patrick Flinn, internet!pflinn@alston.com
           Karl J. Kramer, internet!kkramer@mofo.com
18   Robert Haslam, internet!rhaslam@hewm.com
           Thomas R. Hogan, internet!trh@hoganlaw.com
19
   I declare under penalty of perjury under the laws of the State
20
   of California that the foregoing is true and correct.
21
   Executed in Soquel, Calif. at the date below.
22

23
   Dated: August 4, 1997
24

25 By: _____

26 Plaintiff, Roger Schlafly

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